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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,653	01/14/2006	Gyoon Hee Han	DI-008	1709
38051	7590	12/18/2007	EXAMINER	
KIRK HAHN			FINN, MEGHAN R	
14431 HOLT AVE			ART UNIT	
SANTA ANA, CA 92705			PAPER NUMBER	
			1614	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,653	<b>Applicant(s)</b> HAN ET AL.	
	<b>Examiner</b> Meghan Finn	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

The instant application contains use claims, which could be interpreted as a product, method of treating or method of preparing, and as such are grouped separately. Claims 1 and 15 are linking claims, and will be examined with whichever group is elected, and interpreted based on the group elected.

**Use interpreted as a product:**

Group I, claim(s) 2-3, and 16, drawn to a compound of formula II.

Group II, claim(s) 4-6, 17, drawn to a compound of formula III.

Group III, claim(s) 7-8, 18, drawn to a compound of formula IV.

Group IV, claim(s) 9-10, 19, drawn to a compound of formula V.

Group V, claim(s) 11-13, 20, drawn to a compound of formula VI.

**Use interpreted as a method of treating:**

Group VI, claim(s) 2-3, 16, drawn to a method of treating using compound of formula II.

Group VII, claim(s) 4-6, 17, drawn to a method of treating using compound of formula III:

Group VIII, claim(s) 7-8, 18, drawn to a method of treating using compound of formula IV.

Group IX, claim(s) 9-10, 19 drawn to a method of treating using compound of formula V.

Group X, claim(s) 13, 20, drawn to a method of treating using compounds of formula VI.

**Use interpreted as a method of preparing:**

Group XI, claim(s) 2-3, 16, drawn to a method of preparing a composition using the compound of formula II.

Group XII, claim(s) 4-6, 17, drawn to a method of preparing a composition using the compound of formula III.

Group XIII, claim(s) 7-8, 18, drawn to a method of preparing a composition using the compound of formula IV.

Group XIV, claim(s) 9-10, 19 drawn to a method of preparing a composition using the compound of formula V.

There is no special or common technical feature between all groups, because the special technical feature of a composition claim is the compound itself, while the special technical feature of a method claim is the interaction between the compound and a receptor or body to which it is administered. The special technical feature in a method of preparing is the interaction between chemicals involving in making the composition, and as such is different than both of the special technical features of the compound and method of treating claims. Within the product groupings (groups I-V), there is not special technical feature because the core structure of the compounds vary between each group.

Changing the ring size from 5 to 6 to 7 carbons drastically effects the composition as well as the large differences between the A1 and A2 groups (claim 1), such structural differences would create different core structures and as such there is no special or technical common feature between groups I-V. Since there is a lack of unity between the compositions and there is a lack of unity between a method of treating, method of preparing, and a composition, there is a lack of unity between groups I-XIV and thus restriction is proper.

This application also contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Despite the groupings based on core structure as discussed above, there is still quite a large variation of structures within each group. As different functional groups affect the compound and its effectiveness, a different search is required for each. Additionally, multiple types of cancer have been claimed, and given the large differences between cancers such as prostate cancer and skin cancer, those species also have different search and examination requirements and as such have a lack of unity of invention.

**Regardless of which group is elected, applicant must elect a single disclosed species consisting of 1 compound used in which all variables and R groups have been specified.**

**If a method of treating is elected (groups VI-X), then the applicant must elect a species consisting of a single disclosed specie of cancer disease such as those listed in claims 15-20.**

Applicant is reminded that a single disclosed species must be elected. Thus any compound that is elected will be considered new matter if it has not been specifically disclosed in the specification.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the

restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be

maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-



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free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meghan Finn whose telephone number is (571) 270-3281. The examiner can normally be reached on 7:30am-5pm Mon-Thu, 7:30am-4pm Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Meghan Finn

  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER